

REMARKS

This is a Response to a non-final Office action (Paper No. 1103) mailed 10 November 2003. Claims 27-38 and 40-61 are pending in this application. No amendment is made by this Reply.

In the Interview on 23 October 2003, the examiner informed the applicant that the amendment filed on August 8, 2003 would appear to place the claims in condition for allowance provided that a terminal disclaimer regarding commonly owned and invented U.S. Patent No. 6,584,374.

In the Response filed on October 29, 2003, Applicant properly pointed out and applied the test cited by MPEP section and the case laws to show that the examiner's rejection is not proper. Nonetheless, the examiner improperly asked the applicant to provide further evidence for the applicant's argument in the Office action (Paper No. 1103).

The test for the double patenting is:

"Double patenting results when the right to exclude granted by a first patent is unjustly extended by the grant of a later issued patent or patents." *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982). (Emphasis added) (See also MPEP 804.)

MPEP 804, I states that

"A. Between Issued Patent and One or More Applications

Double patenting may exist between an issued patent and an application filed by the same inventive entity, or by an inventive entity having a common inventor with the patent, and/or by the owner of the patent. **Since the inventor/patent owner has already secured the issuance of a first**

patent, the examiner must determine whether the grant of a second patent would give rise to an unjustified extension of the rights granted in the first patent.” (Emphasis added)

Thus, even if the claims in the second patent are obvious over the first patent claims, the examiner must determine whether the grant of a second patent would give rise to an unjustified extension of the rights granted in the first patent. The examiner did not properly determine this issue.

Here, the filing date of the present application is 21 February 2001, and the filing date of U.S. Patent No. 6,584,374 is March 14, 2001. The term of the ‘374 patent is extended or adjusted under 35 U.S.C. 154(b) by 265 days. Accordingly, unless the term of the present application is extended or adjusted by more than 286 days ($=265+21$), there is no unjustified extension of the rights granted in U.S. Patent No. 6,584,374.

As cited by the examiner, “double patenting is proper when “the grant of a second patent **WOULD** give rise to an unjustified extension of the rights granted in the first patent.” (Emphasis added.). That is, the rule does not say that double patenting is proper when the grant of a second patent **MAY** give rise to an unjustified extension of the rights granted in the first patent.

The examiner merely argued that the amount of adjustment or extension is unknown at this time and could very easily extend past the 286 days cited by applicant. The examiner’s argument is unreasonable. The examiner’s rejection cannot be based on conjecture or speculation. Furthermore, the conjecture or speculation is groundless.

It should be noted that the double patenting doctrine is to prevent only “**unjustified**

extension. The examiner improperly asserted that if the first patent to Lee et al. '374 could be "abandoned" by not paying the maintenance fee, the applicant would extend the right by use of the second patent. The examiner's example is not related to "unjustified extension." The examiner seems to improperly argue that, after prematurely expiring the first patent, any extension of the second patent over the prematurely expired date of the first patent is "unjustified extension." When the first patent prematurely expires or effectively expires, the extension of the second patent to the complete statutory period of the first patent is permitted by the PTO. For example, an applicant may file a petition under 37 CFR §1.182 to withdraw a previously filed terminal disclaimer and submit a new terminal disclaimer, terminating the second patent on the date which would have been the termination date of the first patent. Also, the PTO has indicated a willingness to accept a terminal disclaimer which contains a paragraph making it clear that the patent which issues subject to the terminal disclaimer is to run for the complete statutory period of the first patent, whether or not the first patent itself may prematurely expire for any of the reasons mentioned above. That is, even if the first patent is abandoned by not paying the maintenance fee, the extension of the second issued patent to the complete statutory period of the first patent is not "unjustified extension." In view of this reasoning, here, even if Lee '374 is abandoned by not paying the maintenance fee, there will be no unjustified extension if the present patent term expires prior to the statutory period of Lee '374. Therefore, unless the examiner shows that the present application will expires later than the statutory term period of Lee '374, there is no unjustified extension even if Lee '374 is abandoned by not paying the maintenance fee. The examiner did not properly show an example for "unjustified extension."

Moreover, it is hardly understood how the present application could very easily unjustifiably extend. The patent term begins on the date on which the patent issues and ends 20 years from the date on which the application for the patent was filed in the United States. Where the filing date of the present application is prior to the filing date of Lee '374, how could the present application very easily unjustifiably extend? The applicant respectfully requests the examiner to provide an example showing *unjustified extend*?

To more clarify the pending issue, the examiner's attention is invited to consider the following decision.

If multiple patents were actually issued on the same day, the courts decide that issuance on the same day eliminates any objection of double patenting. *Pursche v. Atlas Scraper & Eng'r Co.*, 300 F.2d 467, 132 USPQ 104 (9th Cir. 1962), *cert. denied*, 371 U.S. 911 (1962), *reh'g denied*, 371 U.S. 959 (1963). The Ninth Circuit considered three patents that issued the same day on applications filed on different dates.

“Patents 090, 091 and 089, their applications being filed in that chronological order, were all issued to Pursche on the same date-January 13, 1953 and they both refer to 090 and expressly state that they extend to “improvements” on the invention embodied in 090. Unless void because they violate the rule, the two later filed patents will expire at the same time as the 090. There would be no extension of the patent monopoly. **The decisions on this point are to the effect that the rule will not operate where the reason for its application is absent.**” 300 F.3d at 481, 132 USPQ at 115. (Emphasis added)

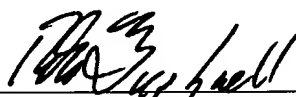
Even if the decision was made before section 532(a)(1) of the Uruguay Round Agreements Act (Pub. L. 103-465, 108 Stat. 4809 (1994)) amended 35 U.S.C. 154, the reasoning behind this

decision shows that the double patenting doctrine does not apply where the reason for its application is absent even if the claims of two or more patents are obvious to each other. Here, as stated above, the filing date of the patent term for the present application is prior to the filing date of the patent term for Lee '374. There is nothing to believe that the right to exclude granted by Lee '374 would be unjustly extended by the grant of the present patent application.

Since the examiner's showing is not related to "unjustified extension" and the grant of the present patent would not give rise to an unjustified extension of the rights granted in Lee '374 patent, the examiner's double patenting rejection is not proper.

No fee is incurred by this Response.

Respectfully submitted,



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